

REMARKS

I. Introduction

Claims 26 to 50 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submit that all of the pending claims are allowable, and reconsideration is respectfully requested.

II. Objection to Claim 41

Regarding the objection to claim 41, the Examiner will note that claim 41 has been amended herein without prejudice as suggested in the Office Action. Accordingly, withdrawal of this objection is respectfully requested.

III. Rejection of Claims 26 to 50 Under 35 U.S.C. § 112

Claims 26 to 50 were rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite. It is respectfully submitted that the present rejection should be withdrawn for at least the following reasons.

Regarding the phrase "in a basic position," the Examiner's attention is respectfully directed, for example, to page 3, lines 23 to 29 of the Specification, which refers to a basic position as "a position in which no dynamic forces or forces as a result of the engagement of the pinion into the rack are active which are suitable for displacing the rack in the direction of the pressure piece."

Regarding claims 27 and 42, these claims have been amended herein without prejudice to change "an exposed end of the pin arranged as a contact face" to --an exposed end of the pin arranged as one of the first contact faces--.

Regarding claim 31, this claim has been amended herein without prejudice to change "of which" to --of the helical spring--.

Regarding claims 35, 36, 48, and 49, these claims have been amended herein without prejudice in self-explanatory manners.

Regarding claim 44, this claim has been amended herein without prejudice to change "as a contact face" to --as one of the first contact faces--.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

IV. Rejection of Claims 26 to 36 Under 35 U.S.C. § 103(a)

Claims 26 to 36 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 5,622,085 ("Kostrzewa") and U.S. Patent No. 4,593,578 ("Kobayashi et al."). It is respectfully submitted that the combination of Kostrzewa and Kobayashi et al. does not render unpatentable the present claims for at least the following reasons.

Kostrzewa does not disclose a stop element in which a first contact face of a stop element is of resilient configuration. Kostrzewa discloses that a yoke spring **32** is disposed between the yoke **30** and a metal plug **34** which is threaded into an opening formed in the housing **12**. See, e.g., col. 2, lines 40 to 42, describing Fig. 1. The yoke spring as disclosed in Kostrzewa cannot be depressed to zero length, and thus the yoke **30** can never come into contact with the metal plug **34**. Because the thin metal surface of the metal plug **34** cannot come into contact with the yoke **30**, it cannot act as a contact face of a stop element. Indeed, the device disclosed in Kostrzewa has no stop element, and provides no manner for the device to support forces that overcome the spring.

Similarly, Kobayashi et al. does not disclose a stop element in which a first contact face of a stop element is of resilient configuration. The nut **4** illustrated in Fig. 2 has only one contact face, which presses against zero, one or two contact faces of the pressure piece **7** depending on the strength of the force pressing the rack against the pinion.

As neither Kostrzewa nor Kobayashi et al. discloses, or even suggests, at least the following feature of claim 26, i.e., "the pressure piece and the stop element are formed from metal, the first contact face of the stop element is of resilient configuration, a second stage of the two stages of pressure beginning as soon as the first contact faces make contact with one another," the combination of Kostrzewa and Kobayashi et al. does not render unpatentable claim 26.

In addition, the Office Action fails to set forth a prima facie case of obviousness consistent with the Supreme Court's KSR decision and consistent with the provisions set forth in M.P.E.P. § 2142 et seq. A rejection under 35 U.S.C. § 103(a) cannot be sustained with mere conclusory statements; rather, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. KSR International Co. v. Teleflex Inc., 82 U.S.P.Q.2d 1385, 1386 (2007). Although the KSR decision and the M.P.E.P. set forth several

rationales that may support a conclusion of obviousness, along with the necessary findings that must be articulated in order to rely on each of these rationales, the Office Action does not adequately identify the rationale, if any, upon which the present rejection is based and does not articulate the requisite findings. Rather, the Office Action merely, and conclusorily, contends that it would have been obvious to combine Kostrzewa and Kobayashi et al. "for the purpose of providing a double bending characteristic that allows the rack guide to bear a higher load for the same displacement value compared with conventional guide racks," which is plainly insufficient to support a prima facie case of obviousness that is consistent with the KSR decision and consistent with the provisions set forth in M.P.E.P. § 2142 et seq.

As for claims 27 to 36, which depend from claim 26, it is respectfully submitted that the combination of Kostrzewa and Kobayashi et al. does not render unpatentable these dependent claims for at least the reasons more fully set forth above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

V. Rejection of Claims 37-40 Under 35 U.S.C. § 103(a)

Claims 37 to 40 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Kostrzewa, Kobayashi et al., and U.S. Patent No. 6,921,096 ("Yang"). It is respectfully submitted that the combination of Kostrzewa, Kobayashi et al., and Yang does not render unpatentable the present claims for at least the following reasons.

Claims 37 to 40 depend from claim 26. As more fully set forth above, the combination of Kostrzewa and Kobayashi et al. does not disclose, or even suggest, all of the features of claim 26, from which claims 27 to 40 depend. Yang does not cure the critical deficiencies noted above with respect to the combination of Kostrzewa and Kobayashi et al. Accordingly, it is respectfully submitted that the combination of Kostrzewa, Kobayashi et al. and Yang does not render unpatentable claims 27 to 40, which depend from claim 26.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

VI. Rejection of Claims 41 to 50 Under 35 U.S.C. § 103(a)

Claims 41 to 50 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 4,322,986 ("Adams") and Kostrzewa. It is respectfully submitted that the combination of Adams and Kostrzewa does not render unpatentable the present claims for at least the following reasons.

Adams does not disclose, or even suggest, that a first contact face of a stop element is of resilient configuration. Elements **17** and **42** described by Adams act as a guide to prevent the rack from rotating on its axis, not a pressure piece to keep the rack engaged with the pinion. Adams describes the peg as a follower (col. 4, lines 53 to 56), and describes the function of the follower as, "[b]y engaging a follower within the track **14** and which follower is secured relative to the housing in the sense that it is not displaceable in the direction of, nor rotatable about, the axis **5**." (col. 4, lines 20 to 24). In other words, the peg **17** acts against the rack to prevent it from rotating, not to prevent vertical displacement from the pinion.

Thus it is clear that Adams does not disclose, or even suggest, that a first contact face of a stop element is of resilient configuration. Furthermore, and as more fully set forth above, Kostrzewa does not disclose, or even suggest, this feature. Accordingly, it is respectfully submitted that the combination of Adam and Kostrzewa does not render unpatentable claim 41.

In addition, the Office Action fails to set forth a prima facie case of obviousness consistent with the Supreme Court's KSR decision and consistent with the provisions set forth in M.P.E.P. § 2142 et seq. in that the Office Action does not adequately identify the rationale, if any, upon which the present rejection is based and does not articulate the requisite findings. Rather, the Office Action merely, and conclusorily, contends that it would have been obvious to combine Adams and Kostrzewa "for the purpose of providing a strong and durable supporting structure for the steering rack," which is plainly insufficient to support a prima facie case of obviousness that is consistent with the KSR decision and consistent with the provisions set forth in M.P.E.P. § 2142 et seq.

As for claims 42 to 50, which depend from claim 41, it is respectfully submitted that the combination of Adams and Kostrzewa does not render unpatentable these dependent claims for at least the reasons more fully set forth above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

VII. Conclusion

In view of the foregoing amendment and remarks, it is respectfully submitted that all pending claims of the present application are now in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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